



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,920	01/26/2004	Forrest P. Gauthier	TES05-GN002-D2	1919

30074 7590 09/09/2004

TAFT, STETTINIUS & HOLLISTER LLP
SUITE 1800
425 WALNUT STREET
CINCINNATI, OH 45202-3957

EXAMINER

GARCIA, GABRIEL I

ART UNIT PAPER NUMBER

2624

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,920

Applicant(s)

GAUTHIER, FORREST P.

Examiner

Gabriel I Garcia

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Part III DETAILED ACTION

1. Applicant should update the serial numbers information with respect to the cross references made to the U.S. applications recited on page 1 of the specification.

2. The abstract of the disclosure is objected to because it is not clearly drawn to the invention being claimed. Correction is required. See MPEP § 608.01(b).

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites the limitation "each of which contain the static bitmap and a variable data bitmap" in lines 15-16. There is not clear antecedent basis for this limitation in the claim.

It is not clear where it is referring to the saved static bitmap or the plurality of documents. Clarification is required. For examination purposes Examiner assumes that it is referring to the each of the documents. Claims 12-13 have similar problems. Clarifications are required.

Double Patenting

6. The claims 1-14 are rejected under the judicially created doctrine of the obviousness type double patenting of the claims in applicant's prior United States Patent No. 5,729,665 , 5,937,153 and 6,381,028. Although the designs are not identical, they are not patentably distinct from each other because both the pending application and the Applications claims are directed to the same invention, a computer implemented method for generating a bitmap suitable for high speed variable printing. (e.g. claim 1 from the application teaches generating (or providing) page description code specification, interpreting and identifying the PDL, storing the character bitmap (or graphics, retrieving the variable data, associating (or linking) the variable data, generating the variable data, and repeating the steps above, these steps are describe in the steps of claims 1 and 2 of US patent No. 5,937,153. (See also claims 1-6 of 5,729,665, and

claims 1-4 of 6,381,028). The obviousness type double patenting rejection is a judicially established doctrine based on public policy, and is primarily intended to prevent prolongation of monopoly by prohibiting a claim in a second patent not patentably distinguishable from a claim in a first patent.

A timely filed terminal disclaimer will obviate this rejection. (MPEP... § 1490) *In re Vogel*, 164 USPQ 619 (CCPA 1970).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herregods et al. (6,064,397) teaches a method for creating multiple documents having identical background regions and page specific image regions.

Norton (6,016,380) teaches a template based edit decision list management system.

Vyncke et al. (5,926,185) teaches a method for processing a set of PDL commands to reduce complexity.

Young (5,852,673) teaches a method for general image manipulation and composition.


McMillin (5,103,490) teaches a method for storing and merging multiple optically scanned images.

Tanaka (4,944,614) teaches a form overlay type printing apparatus. method for storing and merging multiple optically scanned images.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (703) 305-8751. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone numbers for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Gabriel I. Garcia
Primary Examiner
September 7, 2004



GABRIEL GARCIA
PRIMARY EXAMINER